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## PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

1.240.03

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Application Number

10/672,425

Filed

September 26, 2003

First Named Inventor

Arthur Coello

Art Unit

1713

Examiner

Kelechi Chidi Egwim

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☒ attorney or agent of record. 46,716  
Registration number \_\_\_\_\_

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

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November 17, 2006  
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.  
Submit multiple forms if more than one signature is required, see below\*.

☒ \*Total of 1 forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor: Arthur Coello and Carlos Vega Velazquez  
Serial No.: 10/672,425  
Filing Date: September 26, 2003  
For: TEMPORARY AQUEOUS AEROSOL PAINT COMPOSITION AND A METHOD  
FOR PREPARING THE COMPOSITION

**ARGUMENTS IN SUPPORT OF PRE-APPEAL BRIEF REQUEST FOR REVIEW**

The following arguments are presented in support of the Pre-Appeal Brief Request for Review filed in response to the Final Office Action dated May 17, 2006 ("Final Action") in the above-referenced application.

**I. STATUS OF CLAIMS.**

Claims 1-7, 10-11, 14-51, and 54, currently pending in the present application, are directed to a "temporary" aqueous aerosol paint composition having an aqueous paint component "formulated to substantially degrade within four weeks" comprising "an aqueous dispersion of a ... homopolymer," all but claims 22-34 further reciting an aqueous dispersion of a "polyvinyl acetate homopolymer" ("PVA"). Each claim stands finally rejected under 35 U.S.C. §103(a) as unpatentable over Swartz (U.S. Pat. No. 5,250,599), Jamasbi (U.S. Pat. No. 5,451,627), or Suk (U.S. Pat. No. 4,450,253), and as indefinite under 35 U.S.C. §112.<sup>1</sup>

**II. ISSUES FOR REVIEW.**

The issues for review are: i) whether a *prima facie* case of obviousness under 35 U.S.C. §103 has been established, and, if so, ii) whether all rebuttal evidence has been considered.

**III. ARGUMENTS.**

**A. Office Actions Fail to Establish *prima facie* Obviousness.**

Section 2142 of the Manual of Patent Examining Procedure ("MPEP") states that "[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness." Section 2142 further provides:

To establish a *prima facie* case of obviousness, three basic criteria must be met. ***First, there must be some suggestion or motivation,*** either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. ***Second, there must be a reasonable expectation of***

<sup>1</sup> Applicants do not anticipate Appeal of claim rejections under 35 U.S.C. §112, rather, Applicants propose deletion of the "short chain" limitation, thereby rendering this basis for rejection moot.

**success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teachings or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and **not based on the applicant's disclosure.** In re Vaeck, 947 F.2d 488 (Fed. Cir. 1991). (**emphasis added**).

With a chemical composition at issue. the Federal Circuit, *en banc*, reaffirmed that "**structural similarity between claimed and prior art subject matter ... where the prior art gives reason or motivation to make the claimed compositions**" creates a *prima facie* case of obviousness. In re Dillon, 919 F.2d 688, 692 (Fed. Cir. 1990). (**emphasis added**).

1. **No Motivation, Suggestion, or Teaching in the Prior Art.**

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some motivation, suggestion, or teaching to do so. In re Kahn, 441 F.3d 977, 986 (Fed. Cir. 2006). The Federal Circuit has stated that "[t]his court has identified three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." In re Rouffet, 149 F.3d 1350, 1357 (Fed. Cir. 1998).

To begin, the problem solved by the present invention is providing a "temporary" aqueous aerosol paint composition having an aqueous paint component specifically "formulated to substantially degrade" within a short period of time. Conversely, each of the references cited in the Final Action are directed to aerosol paint compositions specifically formulated "to form a water-resistant and durable film" (Suk, Abstract); "for improved drying rates, hardness and alkali resistance" (Jamاسبی, Abstract); or, for improved drying, pH stability, and hardness (Swartz, column 2, lines 32-40). Thus, the "nature of the problem to be solved" by the present invention is not addressed or suggested in any the cited references, rather, the cited references "teach away" from the solution to the problem solved by the present invention.

Applicants' selection of PVA as the polymeric resin, a selection based upon extensive testing of numerous polymeric resins to develop a composition exhibiting the desired properties [see paragraphs 6, 10, 11, and 12 of the "Declaration of Arthur Coello," co-inventor of the present invention ("Declaration"), filed with the Amendment dated March 23, 2006], was summarily dismissed in the Final Action, as a "conventional additive." Looking to the "teachings of the prior art," however,

Applicants note that neither this "conventional additive," i.e., PVA, nor an "aqueous dispersion of a ... homopolymer" are disclosed in any of the references cited in the Final Action. Thus, the cited references fail to teach all of the limitations of Applicants' claimed composition.

Further, in accordance with paragraph 9 of the Declaration, prior to the invention of the present composition, Applicants were informed by three different engineers at the Instituto Mexicano Del Petrolio, each having expertise in the art, that it is impossible to formulate a "temporary" aerosol paint composition without volatile organic compounds harmful to users and the environment. As such, persons of ordinary skill in the art at the time of the invention would not be motivated to attempt to modify any of the cited references to arrive at the new and unobvious composition of the present invention, as there was no reasonable expectation of success, rather, there was an expectation of failure.

Rouffet also provides that "even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination." Id. at 1359. In other words, the reason one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious under 35 U.S.C. §103 must be identified. The Final Action, however, merely states that PVA is a "conventional additive," even though it is not disclosed in any of the references.

**a. Modification Rendering Prior Art Inoperable Teaches Away.**

It has been held that a modification which renders prior art inoperable for its intended purpose, in effect, teaches away from the proposed modification. In re Gordon, 733 F.2d 900, 902 (Fed. Cir. 1984). The cited references are specifically formulated to improve durability, hardness, or alkali/pH stability, whereas Applicants' composition is formulated to "substantially degrades" in a short period of time. Thus, the modification suggested in the Final Action renders each of the prior art compositions inoperable, thereby teaching away from the modification.

Applicants respectfully submit that the Final Action fails to establish any teaching, suggestion or motivation, either in the references or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings to arrive at Applicants' novel and unobvious formulation.

**2. No Reasonable Expectation of Success.**

As stated in paragraph 9 of the Declaration, three engineers, persons having expertise in the art, stated that it was impossible to formulate a "temporary" aerosol paint composition without volatile organic compounds harmful to users and the environment. Thus, persons of ordinary skill in the art at the time of the invention had no reasonable expectation of success, rather, they had an expectation of failure.

**3. References Fail to Teach or Suggest All Claim Limitations.**

The references cited in the Final Action wholly fail to disclose either an aqueous dispersion of a homopolymer or PVA, and nowhere does the Final Action identify any suggestion of an aqueous dispersion of a homopolymer or PVA in any reference. Thus, the cited references fail to teach all of the components which comprise the claimed composition.

**4. No Structural Similarity Between Invention and Prior Art.**

Each of the claims currently pending in the present application recite an "aqueous dispersion of a ... homopolymer." Conversely, each of the cited references are directed to polymeric resin systems comprising either blends of polymers and copolymers (Swartz, Abstract), blends of thermoplastic acrylic polymers with water soluble or water reducible acrylic polymers (Jamasbi, Abstract), or oil modified film-forming polymers (Suk, Abstract). The Final Action fails to establish any basis for a finding of "structural similarity" between the "aqueous dispersion of a ... homopolymer," as claimed, and any of the resin systems disclosed in any of the cited references. Applicants respectfully submit that there is no "structural similarity" between the "aqueous dispersion of a ... homopolymer" as claimed in the present application, and any polymeric resin system disclosed in the cited references.

**5. Conclusory Statement Insufficient for *prima facie* Obviousness.**

The courts have held that the Board cannot rely on conclusory statements, such as, "**would have been obvious to one of ordinary skill in the art,**" to support claim rejections, rather, it must set forth the rational on which it relies. In re Lee, 277 F.3d 1338 (Fed. Cir. 2002). Further, "deficiencies of the cited references cannot be remedied by ... general conclusions about what is 'basic knowledge' or 'common sense' to one of ordinary skill in the art." In re Zurko, 258 F.3d 1379, 1385 (Fed. Cir. 2001).

The basis for claim rejections under 35 U.S.C. §103 is found on page 3 of the Final Action, which merely states that although the cited references "do not disclose [Applicants'] *conventional aerosol paint additives ... it would have been obvious to one having ordinary skill in the art*, at the time the invention was made, to include these *conventional additives* to the aerosol paint compositions." Without more, the Final Action fails to establish a *prima facie* case of obviousness.

**B. Final Action Fails to Consider All Rebuttal Evidence.**

The Federal Circuit has held that "[a]n applicant may rebut a *prima facie* case of obviousness by providing a 'showing of facts supporting the opposite conclusion.' Such a showing dissipates the *prima facie* holding and requires the examiner to 'consider all of the evidence anew.'" In re Kumar, 416 F.3d 1361, 1368 (Fed. Cir. 2005). The court further held that "***[t]he entirety of the evidence must be reviewed in order to determine whether the claimed invention as a whole would have been obvious*** to a person of ordinary skill in the field." Id. at 1369. (***emphasis added***).

The Final Action includes a response to several of Applicants' arguments, however, the Final Action fails to consider all of the rebuttal evidence presented. Specifically, the Final Action fails to acknowledge the fact that Applicants consulted with experts prior to the invention and were told that the composition desired, and ultimately achieved, was impossible to formulate. Further, the Final Action fails to address the fact that the cited references are directed to compositions which, as a whole, teach away from Applicants' formulation such that Applicants' claimed invention, as a whole, can not be found obvious in view of the cited references. Thus, the Final Action not only fails to consider **all** of the evidence presented by Applicants, the evidence which was considered has not been reviewed to determine if the claimed invention **as a whole** would have been obvious.

**IV. CONCLUSION.**

Based on the foregoing arguments, it is evident that the Final Action fails to establish a *prima facie* case of obviousness as to any of the claims pending in the present application. Even if a *prima facie* case were established, the Examiner failed to consider all of the evidence prior to reasserting his original obviousness rejection.

Therefore, claims 1-7, 10-11, 14-51, and 54 are all believed to be allowable, upon amendment to address rejection under 35 U.S.C. §112.